                    37 CFR 41.50(b)(2) REQUEST FOR REHEARING

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I.   This request was expressly authorized under 37 CFR 41.50(b) in the 7/1/2011 decision on rehearing requested 3/11/2011. See 7/1/2011 Decision, at 7:17-20.

II.   7-1-2011 The decision on reconsideration contains an ambiguous authorization for further review.

37 CFR 41.50(b) reads as follows: (b)Should the Board have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in its opinion a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim. A new ground of rejection pursuant to this paragraph shall not be considered final for judicial review. When the Board makes a new ground of rejection, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims: (1)Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or new evidence not previously of record is made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. Should the examiner reject the claims, appellant may again appeal to the Board pursuant to this subpart. (2)Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. The request for rehearing must address any new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in entering the new ground of rejection and

also state all other grounds upon which rehearing is sought.

37 CFR 41.52 reads as follows: 41.52 Rehearing. (a)(1)Appellant may file a single request for rehearing within two months of the date of the original decision of the Board. No request for rehearing from a decision on rehearing will be permitted, unless the rehearing decision so modified the original decision as to become, in effect, a new decision, and the Board states that a second request for rehearing would be permitted. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked by the Board. Arguments not raised in the briefs before the Board and evidence not previously relied upon in the brief and any reply brief(s) are not permitted in the request for rehearing except as permitted by paragraphs (a)(2) and (a)(3) of this section. When a request for rehearing is made, the Board shall render a decision on the request for rehearing. The decision on the request for rehearing is deemed to incorporate the earlier opinion reflecting its decision for appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision on rehearing.(2) Upon a showing of good cause, appellant may present a new argument based upon a recent relevant decision of either the Board or a Federal Court.(3) New arguments responding to a new ground of rejection made pursuant to § 41.50(b) are permitted.(b) Extensions of time under § 1.136(a) of this title for patent applications are not applicable to the time period set forth in this section. See § 1.136(b) of this title for extensions of time to reply for patent applications and § 1.550(c) of this title for extensions of time to reply for ex parte reexamination proceedings.[Added, 69 FR 49959, Aug. 12, 2004, effective Sept. 13, 2004]

7-1-2011 The decision on reconsideration states that:

3. In response to the alternative basis offered in our Decision for affirming the Examiner's rejection of claim 24 based on an obviousness rationale, (Decision, page 8, 11. 1-15), Appellants argue that " ... appellant notes that this is not a basis for rejection raised by the examiner in the Examiner's Answer. It is also not a basis of rejection that could reasonably have been anticipated by the appellant for the reasons noted below. Therefore, the appellant has not had a 'fair opportunity to react to the thrust of the rejection'". (Request, 3).

We will grant Appellants ' request to allow Appellants an opportunity to respond as our rationale here lies at the nub of this appeal. We note that we make this grant not based on any error of our own, but only to the extent that this portion of our Decision, (page 8, 11. 1-15), used a rationale which differed from that applied by the Examiner. ***

Our decision to affirm the decision of the Examiner to reject the claims on appeal under 35 U.S.C. § 103(a) over the prior art has not been shown to have been erroneous. Because in so affirming we used a different rationale than that articulated by the Examiner, we grant the request for rehearing to the extent that we denominate the Decision a new ground of rejection under 37 C.F.R. § 41.50(b).

The Appellant assumes the rationale referred to in the authorization for rehearing is that specified at the 3-11-20011 BPAI Decision, page 8:1-15, for the following reasons. Appellant's 3-11-2011 request for rehearing contains no "Request, 3" but does contain a "POINT 3". Appellants 3-11-2011 request for rehearing in its "Request, 3" does not refer to "(Decision, page

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8, 11. 1-15)", but it does refer to the alternative basis for affirmance at "Decision 8:1-15". The appellant cannot meaningfully interpret "Decision, page 8, 11. 1-15" as anything other than "Decision 8:1-15". Thus, Appellant assumes that the authorization relates to the new ground of rejection specified at Decision, page 8:1-15.

The scope of authorized review is ambiguous. On reconsideration, the panel stated that "We will grant Appellants' request to allow Appellants an opportunity to respond as our rationale ..." However, 51.50(b) requires the authorization to be based upon a new ground of rejection, and 41.52(b) authorizes "New arguments responding to a new ground of rejection made pursuant to § 41.50(b)." Accordingly, grant of a right pursuant to 41.50(b) to rehearing accords a right to respond to the ground for the rejection, not (merely) the new rationale. A new ground of rejection is, although not expressly stated, based upon Jovicic.

III.   The 3-11-2011 BPAI Decision at 8:1-15 reads:

Notwithstanding, even reading claim 24 to require the remote Web site and the Web site of said manufacturer be separated by the Internet, we do not find this to be a patentably distinct feature. This is because both implementations are within the level of skill of the ordinary artisan, because centralized and distributed computer implementations are old and wellknown, as is operating two web sites on one server. Further, since different modules of computer code are commonly used to do different elements of work, having code modules operate within one server with local communication between them, or, alternatively, having the code modules operate in distributed web sites with remote inter-process communications between them, does not alter the

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function collectively performed by the several modules. See, In re American Academy 0/ Science Tech Center, 367 F.3d 1359, 1369 (Fed. Cir. 2004). ("it was proper for the Board to construe "user computer" to encompass the [multi-user] mainframes and [distributed, single-user] minicomputers of the cited prior art.")

IV.   RESPONSE TO NEW RATIONALE/GROUND OF REJECTION

NEW RATIONALE

The 3-11-2011 BPAI Decision at 8:1-15 rationale is that programming techniques and architectures were well known and therefore colocating in the same computer server or separately locating in different computer servers ("centralized and distributed"; "different modules of computer code") were alternative design choices. However, these conclusions about obviousness of system architecture do not address claim limitations.

V.   CLAIM 24 - The rejection based upon Jovicic makes the following correspondence of elements to claim recitations.

CLAIM   JOVICIC

consumer computer - Internet Node (PC) 122

web site of a manufacturer - Internet Coupon Server 124 (ICS)

remote Web site - Internet Coupon Notification Center 134 (ICNC)

Claim 24 recites "in response to said request [SIC; 'a request for manufacturer incentives to purchase one of a product and a service offered by said manufacturer'] for manufacturer incentives, transmitting region data from said Web site of said manufacturer over the Internet to

a remote Web site; in response to receipt of region data at said manufacturer' s Web site, transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer;".

Claim 24 defines the remote Web site acting in response to receipt of region data at the manufacturer Web site. Claim 24 recites "in response to receipt of region data at said manufacturer' s Web site, transmitting from said remote Web site to said Web site of said manufacturer".

Jovicic discloses the ICNC receiving notification of coupon generations from the Coupon Server. The last sentence of the Jovicic specification discloses the Internet Coupon Notification Center (ICNC) can update coupon data in the Internet Coupon Server (ICS) database. It states "Additionally, the ICNC may contain a control system which would enable it to access Internet Coupon Server's coupon data base and change the coupon information electronically." Jovicic contains no other disclosure of the ICNC transmitting to the Internet Coupon Server (ICS). Therefore, Jovicic does not disclose "in response to receipt of region data at said manufacturer' s Web site [Jovicic, ICS], transmitting from said remote Web site [Jovicic, ICNC] to said Web site of said manufacturer [Jovicic, ICS]". Nothing in Jovicic suggests a reason for the ICNC to act "in response to receipt of region data at said manufacturer' s Web site [Jovicic, ICS]" as required by claim 24.

The new rationale in the 7/1/2011 decision alleges that co-locating versus physically separating web sites, and location of code modules are implementation details, suggesting that such modifications provide no patentable distinction.

In response, the appellant submits that no change of code location, to the same or

different servers, would suggest the claimed "in response ... transmitting". Assuming arguendo colocated manufacturer and remote web sites, claim 24 still requires the remote web site acting "in response to receipt of region data at said manufacturer' s Web site" and still requires that response to be "transmitting from said remote Web site to said Web site of said manufacturer at least one manufacturer incentive and at least one name and address of a retailer".

Jovicic fails to disclose the responsive nature of the transmission from the remote web site, regardless whether or not the remote web site is located on a physically remote server from the manufacturer web site. That is, Jovicic fails to disclose the ICNC responding to receipt of region data received by the ICS. There is nothing in Jovicic or the art relied upon in the rejections to suggest the responsive nature noted above.

The same reasoning applies to independent claims 36, 48.

VI.   CLAIM 28 - The rejection based upon Jovicic makes the following correspondence of elements to claim recitations.

CLAIM   JOVICIC

consumer computer - Internet Node (PC) 122

Web site of said retailer - Internet Coupon Server 124 (ICS

remote Web site - Internet Coupon Notification Center ICNC 134 (ICNC)

Claim 28, with the Jovicic correspondences added in brackets, recites "in response to receipt of said request at said Web site of said retailer [Jovicic, ICS], transmitting said request from said Web site of said retailer [Jovicic, ICS] over the Internet to a remote Web site [Jovicic, ICNC]; in response to receipt of said request at said remote site [Jovicic, ICNC], transmitting from said remote site [Jovicic, ICNC] over the Internet to said Web site of said retailer [Jovicic,

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ICS] a list of manufacturer incentives;"

Claim 28 defines the remote Web site acting "in response to receipt of said request". The antecedent for "said request" is "request for manufacturer incentives to purchase one of a product and a service offered by a manufacturer". Jovicic does not disclose the ICNC acting in response to a request transmitted to the ICNC from the ICS. Even assuming arguendo that the ICNC received from the ICS a complete record of each coupon transaction effected by the ICS, nothing in Jovicic disclose or suggests the ICNC acting in response to that information.

The new rationale in the 7/1/2011 decision alleges that co-locating versus physically separating web sites, and location of code modules are implementation details, suggesting that such modifications provide no patentable distinction. In response, the appellant submits that no change of code location, to the same or different servers, would suggest the claimed "in response ... transmitting". Assuming arguendo colocated manufacturer and remote web sites, claim 28 still requires the remote web site acting "in response to receipt of region data at said manufacturer' s Web site" and still requires that response to be "transmitting...to said Web site of said retailer a list of manufacturer incentives".

Jovicic fails to disclose the responsive nature of the transmission from the remote web site, regardless whether or not the remote web site is located on a physically remote server from the manufacturer web site. That is, Jovicic fails to disclose the ICNC responding to receipt of the request, as defined by claim 28. There is nothing in Jovicic or the art relied upon in the rejections to suggest the responsive nature noted above.

The same reasoning applies to independent claim 40, 49.

VII.   ADDITIONAL FACTS

The appellant notes the following facts for purposes of court appeal. The BPAI panel need not review or comment on them, although they are welcome to do so.

A definition of "response" is "(communications) reply (control systems) A quantitative expression of the output of a device or system as a function of the input. Also known as system response. (statistics) The value of some measurable quantity after a treatment has been applied." Definition at http://encyclopedia2.thefreedictionary.com/response on 7/30/2011. Another definition or "response" is "noun - a reaction... - an answer to a question in a test, quiz, etc.... - a reply to any question or letter".

Applicant's specification identifies the significance of geographical region information. "Manufacturers' offers are typically national in scope, whereas retailers' specials are generally local to a specific geographical region. " Specification 1:24-25.

Applicant's specification discloses the "SMO site 14 uses zip code information from a consumer to identify retailers in the consumers geographic region. If not, the consumer is now asked to enter a ZIP code. If so, this step is bypassed. Once the ZIP code is obtained, the SMO site 14 queries the database 16 for a list of retailers in that ZIP code having offers from the manufacturer, as indicated in block 36. " Specification 9:20-26.

3-11-2011 BPAI Decision, 6:4-7. "In order to benefit the manufacturer, it stands that the coupon providing web site act as agent of a manufacturer, or operated on its behalf. Therefore, we find that Jovicic's coupon server meets the claim limitation of a web site of a manufacturer." The appellant agrees.

Jovicic does not disclose the ICNC responding to a "request" for coupon data received by the Coupon Server.

Jovicic 3:30-38 reads "During an on-line connection between an Internet node and the Internet Coupon Server, the Internet coupon server accepts coupon selection from a user, and then transmits the unique Internet coupon back to the user's printing device or user's electronic mail storage device. It further records the transaction to the coupon's Internet Coupon Notification Center which at the time of actual purchase will verify coupon's validity, update user's billing information and record coupon's redemption."

Jovicic 3:30-38 is part of the "BRIEF SUMMARY OF THE INVENTION" section, paragraph 2.

Jovicic 9:24-30 clarifies what 3:30-38 means by "records the transaction to the coupon's Internet Coupon Notification Center" means.

Jovicic 9:24-30 states that "After the transaction is recorded, the Internet Coupon Server 124 notifies the transaction 512 over the Internet Coupon ICNC gateway to the coupon owner's ICNC 134 by first sending customer's name 320, then customer's identification number 322 and then the current coupon serial number 318. After the ICNC 134 has been notified, the Internet Coupon Server 124 updates 514 the coupon serial number 318 which serves as a coupon's unique indicia."

Jovicic 3:52-54 states that "the Internet Coupon Server being coupled to the Internet Coupon Notification Center, the Internet Coupon Server comprising a memory for storing electronic coupons received from an Internet Coupon Server's supplier, a central processing unit for generating and transmitting electronic coupons and for recording and transmitting electronic coupon transactions, ...".

Jovicic 7:56-64 states that "According to the present invention, user's general computing

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device connected to the public network such as the Internet 122, establishes an on-line session with the Internet Coupon Server 124, preferably goes through the registration process 408 if the user is a new user, and then, after the coupon generation process 410 described in detail below, makes a selection 412 from the available coupons in the Internet Coupon Server's browsing memory 128 which contains a selection of coupons organized in a data base. "

Jovicic 10:22-37 states that "FIG. 7 illustrates the preferred embodiment of the coupon generation process 410 wherein the Internet Coupon Server 124 first invokes 702 coupon database 130 and takes the information contained in the coupon data base fields 2,3,4,5,6,7,8,9 and 10 as illustrated in Table 1. Internet Coupon Server 124 then invokes the user database 126 and takes the name of the current user, current user's identification number, user's Internet address, and user's personalized message (if any) used for micro marketing techniques. All coupon elements are then placed in combination, in the Internet Coupon Server's browsing memory 128, ready for user's perusal. In the preferred embodiment of the present invention, the Internet node 102 will access Internet Coupon Server's browsing memory 128 during the on-line session over public computer network such as the Internet 122 using Internet Protocol (IP)."

Jovicic 10:37-45 states that "In the event that the Internet Coupon Server 124 does not contain the user data base 126, it is contemplated in the scope of present invention that a combination of coupon elements described in FIG. 3 could be placed directly in the browsing memory 128, without the added features of elements 320, 322, 324, 326 or without the added feature of an element representing coupon serial number 318 in the event that Internet Coupon Server 124 does not contain the coupon data base 130."

Jovicic 4:10-15 discloses that it is the Internet Coupon Server that generates and stores in

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its database coupons, stating that "The Internet Coupon Server, utilizes a method of operation comprising the steps of generating a new electronic coupon with a unique serial number upon the beginning of an on-line session with an Internet node, transmitting the selected electronic coupon over a public computer network, and recording the transmission in the coupon data base."

Jovicic 11:41-43 discloses that "Furthermore, the ICNC may contain a demographic research system which would access Internet Coupon Server's registration data base and coupon data base and research demographic information. "

Truly,

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Date/time code: July 30, 2011 (8:07pm)

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